REMARKS

In the present Amendment, claim 1 has been amended to recite that the ink set comprises a black ink containing a dye represented by formula (1) as shown in the claim. Section 112 support for this amendment may be found, for example, in the paragraph bridging pages 10 and 11 of the specification, and in the working Examples.

Claims 4, 5 and 6 have been amended to make clear that the recited "dye" is the dye having an oxidation potential more positive than 1.0 V (vs SCE). Claim 5 has also been amended to use proper Markush language.

Claim 7 has been amended to end with a period.

Claim 8 has been amended to recite that the image recording method comprises "hitting" an ink in the inkset on a recording material. Section 112 support for this amendment may be found, for example, in the description beginning at the first full paragraph on page 219 of the specification.

New claims 9 and 10 have been added. Section 112 support for claim 9 may be found, for example, at page 11, last paragraph to page 13, line 14 of the specification. Section 112 support for claim 10 may be found, for example, in the paragraph bridging pages 9 and 10 of the specification.

No new matter has been added, and entry of the Amendment is respectfully requested.

Upon entry of the Amendment, claims 1-10 will be pending.

In Paragraph No. 3 of the Action, claims 5 and 8 are rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite.

In claim 5, the Examiner states, the phrase "selected from" is considered indefinite since this is improper Markush language. In claim 8, the Examiner states, the term "using" is indefinite. The Examiner states that a process defined in the sole terms of "using" does not define patentable subject matter under §101. The Examiner suggests incorporating ink jet recording steps into this claim to overcome the rejection.

In response, claim 5 has been amended to employ proper Markush language, and claim 8 has been amended to recite "hitting" the ink on a recording material.

Reconsideration and withdrawal of the section 112, second paragraph, indefiniteness rejection are respectfully requested.

In Paragraph No. 5 of the Action, claims 1-8 are rejected for obviousness-type double patenting as allegedly being unpatentable over claims 1, 3, 4, 6, 8 and 12 of U.S. Patent 6,939,399.

Applicants submit herewith a Terminal Disclaimer to obviate this rejection.

In Paragraph No. 6 of the Action, claims 1-4 and 6-8 are provisionally rejected for obviousness-type double patenting as allegedly being unpatentable over claims 1-3, 5 and 6 of copending Application No. 10/809,955 (U.S. 2004/0187733).

Applicants submit herewith a Terminal Disclaimer to obviate this rejection.

In Paragraph No. 7 of the Action, claims 1-8 are provisionally rejected for obviousness-type double patenting as allegedly being unpatentable over claims 1, 10, 11 and 14-16 of copending Application No. 10/806,424 (U.S. 2004/0194660).

Applicants submit herewith a Terminal Disclaimer to obviate this rejection.

In Paragraph No. 8 of the Action, claims 1-8 are provisionally rejected for obviousness-type double patenting as allegedly being unpatentable over claims 1, 9, 10, 13 and 14 of copending Application 10/807,442 (U.S. 2004/0200385).

Applicants submit herewith a Terminal Disclaimer to obviate this rejection.

In Paragraph No. 9 of the Action, claims 1-8 are provisionally rejected for obviousness-type double patenting as allegedly being unpatentable over claims 1-4, 6, 8, 10, 12 and 13 of copending Application No. 10/802,797 (U.S. 2004/0246321).

Applicants submit herewith a Terminal Disclaimer to obviate this rejection.

In Paragraph No. 10 of the Action, claims 1-8 are provisionally rejected for obviousness-type double patenting as allegedly being unpatentable over claims 1, 7, 8 and 11 of copending Application No. 10/805,251 (U.S. 2005/0001890).

The '251 application has recently issued as U.S. Patent 6,923,854. Applicants submit herewith a Terminal Disclaimer with respect to the '854 Patent to obviate this rejection.

In Paragraph No. 11 of the Action, claims 1-8 are rejected under 35 U.S.C. § 102(a) as allegedly being anticipated by EP 1340796.

EP '796 was published on September 3, 2003 and is prior art solely under 35 U.S.C. § 102(a). EP '796's effective date of September 3, 2003 is later in time than Applicants' first priority date of March 27, 2003. To perfect their claim to priority and to remove EP '796 as a reference, Applicants submit herewith a sworn English translation of their first priority document, JP 2003-088356. Section 112 support for the present claims in the priority document is as shown in the following chart:

Present Claim	Support in Priority Document
Claim 1	Claim 1; Paragraph Nos. [0017] to [0019]
Claim 2	Claim 1
Claim 3	Claim 2
Claim 4	See, e.g, Paragraph No. [0087], (Formula (M-I))
Claim 5	Paragraph No. [0155]
Claim 6	See, e.g., Paragraph Nos. [0087] (Magenta Dye) and [0149] and [0154] (Cyan Dye)
Claim 7	See, e.g., Paragraph No. [0319]
Claim 8	Paragraph Nos. [0364] et seq.
Claim 9	Paragraph Nos. [0019] to [0021]
Claim 10	Paragraph No. [0016]

In view of the above, withdrawal of the § 102(a) rejection based on EP '796 is respectfully requested.

In Paragraph No. 12 of the Action, claims 1-8 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Takashima et al (U.S. 2004/0246321).

Takashima et al '321's §102(e) date of March 18, 2004 is later in time than both of Applicants' priority dates. To perfect their claim to priority and to remove Takashima et al '321 as a reference, Applicants submit herewith a sworn English translation of their first priority document, JP 2003-088356. Section 112 support for the present claims in the priority document

is shown in the chart above. Accordingly, withdrawal of the § 102(e) rejection based on Takashima et al '321 is respectfully requested.

In Paragraph No. 13 of the Action, claims 1-8 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Taguchi et al (U.S. 2005/0001890).

In response, Applicants point out that the inventors of the present application are the same as the inventors of Taguchi et al '890. In other words, the inventive entities of the present application and Taguchi et al '890 are the same.

Absent a statutory bar, such as under 35 U.S.C. § 102(b), an inventor's own work is not prior art with respect to him. Accordingly, this rejection is improper and should be withdrawn on that basis.

Reconsideration and withdrawal of the rejection are respectfully requested.

In Paragraph No. 14 of the Action, claims 1-8 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Yabuki (U.S. 6,939,399).

Applicants submit that this rejection should be withdrawn because Yabuki '399 does not disclose or render obvious the ink set of the present invention.

In this regard, Yabuki '399 has no disclosure or suggestion of a black ink containing a dye represented by formula (1) and also has no disclosure or suggestion of an ink set containing the same. Therefore, Applicants believe that the present invention has a novelty over Yabuki '399.

To remove Yabuki '399 as prior art under § 102(e) for purposes of § 103, Applicants provide a statement of common ownership, as follows:

Statement of Common Ownership:

The present application and Yabuki U.S. 6,939,399 were, at the time the invention of the present application was made, commonly owned by Fuji Photo Film Co., Ltd.

In view of this statement of common ownership, Yabuki '399 is disqualified as prior art for purposes of section 103 with respect to the present application. See 35 U.S.C. § 103(c).

Accordingly, the Examiner is respectfully requested to withdraw the section 102(e) rejection of claims 1-8 based on Yabuki '399.

While not noted by the Examiner, the prior publication of Yabuki '399 on February 5, 2004 is prior art under §102(a). This prior publication date is later in time than Applicants' first priority date of March 27, 2003. To perfect their claim to priority and to remove the prior publication of Yabuki '399 as a reference, Applicants submit herewith a sworn English translation of their first priority document, JP 2003-088356. Section 112 support for the present claims in the priority document is as shown in the above chart.

In view of the above, the prior publication of Yabuki '399 is not prior art with respect to the present claims.

In Paragraph No. 15 of the Action, claims 1-8 are rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Ishizuka et al (U.S. 2004/0024085).

Applicants submit that this rejection should be withdrawn because Ishizuka et al '085 does not disclose or render obvious the ink set of the present invention.

Ishizuka et al '085, like Yabuki '399, has no disclosure or suggestion of a black ink containing a dye represented by formula (1) and also has no disclosure or suggestion of an ink

set containing the same. Therefore, Applicants believe that the present invention has a novelty over Ishizuka et al '085.

While not noted by the Examiner, Ishizuka et al '085 is also prior art under section 102(a), as of February 5, 2004. This date is later in time than Applicants' first priority date of March 27, 2003. To perfect their claim to priority and to remove Ishizuka et al '085 as section 102(a) prior art, Applicants submit herewith a sworn English translation of their first priority document, JP 2003-088356. Section 112 support for the present claims in the priority document is as shown in the above chart.

Ishizuka et al '085 is thus prior art with respect to the present application solely under § 102(e), as of its U.S. filing date of January 29, 2003.

To remove Ishizuka et al '085 as prior art under § 102(e) for purposes of § 103, Applicants provide a statement of common ownership, as follows:

Statement of Common Ownership:

The present application and Ishizuka et al U.S. 2004/0024085 were, at the time the invention of the present application was made, commonly owned by Fuji Photo Film Co., Ltd.

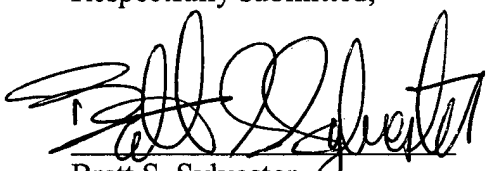
In view of this statement of common ownership, Ishizuka et al '085 is disqualified as prior art for purposes of section 103 with respect to the present application. See 35 U.S.C. § 103(c).

Accordingly, the Examiner is respectfully requested to withdraw the section 102(e) rejection of claims 1-8 based on Ishizuka et al '085.

Allowance is respectfully requested. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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